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09/857,396	05/31/2001	Joseph M. Iglesias	480032-322	4728

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11/04/2003

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EXAMINER

MATHEW, FENN C

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,396

Applicant(s)

IGLESIAS ET AL.

Examiner

Fenn C Mathew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 5,18,19,27,42-46,51,53 and 57-60 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50,52 and 54-56 is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,13-17,20-26,30-34,36-38,40 and 47-49 is/are rejected.
- 7) ☒ Claim(s) 12,28,29,35,39 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species 8 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Furthermore, examiner has not treated claims 59-60, as it is felt that the claims are not drawn to the chosen embodiment.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 rejected under 35 U.S.C. 102(b) as being anticipated by Peters (U.S. 5,366,439). Referring to claim 1, Peters discloses in figs. 12-15, in column 8, lines 40-68, and in column 9, lines 1-68 and orthopedic support comprising an outer shell (68) formed for fitting about the leg of a wearer, a molded pad (66) bonded to the shell, the pad having a surface and a plurality of molded structures comprising walls to provide differing levels of cushioning support, at least some of the structures having a different dimension than others of the structure. The molded structure does provide as disclosed in column 8, lines 44-48, some cushioning even without inflating or otherwise filling the molded structure.

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4. Referring to claims 2 and 3, Peters discloses in fig. 15, and in column 8, lines 40-68 an over-mold (the structure around the perimeter creating a seal) substantially surrounds the pad and the shell substantially sealing together the orthopedic support. The over-mold is molded onto the shell, the pad bonded to the over-mold.
5. Referring to claim 4, Peters discloses in fig. 15, a means for securing (44, 460 the ankle support around the lower leg and a heel strap (10) for securing the orthopedic support.
6. Referring to claim 9 and 10, Peters discloses in fig. 14 that the pad further comprises a plurality of fingers (some of the bubbles) extending from the pad to the outer shell and that the fingers are integrally molded with the pad.
7. Referring to claim 13, Peters discloses in figs. 12-15 and columns 4 and 5, lines 68 and 1-3, a substantially rigid shell and a resilient pad between the shell and the user configured with circular cells.
8. Referring to claim 14, see above rejection of claim 2.
9. Referring to claim 15, Peters discloses in figs. 12-15, and in columns 8 and 9 lines 57-68, and 1-7 a pad that is a bladder having a plurality of geometric shaped cells of predetermined size that localize support and cushion the user.
10. Referring to claim 16, Peters discloses in column 9, lines 14-19 that the geometric shapes can be triangular or rectangular, a regular polygon.
11. Referring to claim 17 and 21, Peters discloses in columns 8 and 9, lines 65-68 and 9, a padding having channels on the outer wall of the pad and allows the lip around

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the shell and pad seals the pouch such that air is trapped between the pad and shell creating a bladder with an air cushion.

12. Referring to claim 22, see the above rejection of claim 15, and column 8, lines 40-50 disclose the pad is molded directly to the shell. The pad has other supportive geometrical shapes to cushion and support the leg.

13. Referring to claim 23, see above rejection of claims 9-10.

14. Claims 11, and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (U.S. 5,007,111). Referring to claim 11, Adams discloses in figs. 1-2B, and 6-11, in column 3, lines 42-59, in column, lines 1-3 and 21-36, and in column 7, lines 21-68 an orthopedic support comprising an outer shell a molded pad bonded to the shell, the pad having a surface ad a plurality of molded structures to provide differing levels of cushioning support for the wearer, a least some of the structures having different dimensions than others of the structures. Adams further discloses a plurality of fingers extending from the pad to the outer shell forming a fluid filled bladder and some of the fingers have a different length than others.

15. Referring to claim 47, Adams discloses in the above mentioned sections, an outer shell formed for fitting about the lower leg of the wearer, a molded pad bonded to the shell, the pad having a plurality of molded structures in between the pad and the shell to provide cushioning for the wearer. Adams discloses in column 5, lines 53-68 that the molded structure is made of a resilient material and thus can provide cushioning support for anatomy without inflating or filling the structures.

16. Referring to claim 48, see above rejections of claims 11 and 47.

17. Referring to claim 49, Adams discloses in figures. 1-2A and in column 6, lines 21-31 the molded pad bonded to the shell, the pad having a substantially continuous surface and having a plurality of molded structures to provide differing levels of cushioning support for the wearer and adapted to be placed against a portion of the anatomy to be supported.

18. Referring to claim 24, Adams discloses in figs. 16 and 17, and in column 7, lines 12-24 an orthopedic support comprising a substantially rigid shell 930), an injection molded pad (34) being integrally molded in a single molded step.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 6-8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Grim (U.S. 4,977,891). Peters discloses all the elements recited in claim 1, however, Peters does not disclose an inner liner of cloth secured to the pad on the surface of the pad facing the lower leg. Grim teaches in fig. 6, and in column 4, lines 57-66 that it is known in the art to include an inner liner of cloth secured to an integrated with the pad on the surface of the pad for the comfort of the user. In addition openings (96) are included in the liner to provide comfort to the user. It would have

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been obvious to one skilled in the art to include an inner liner in order to provide comfort to the user.

21. Referring to claim 20, Grim teaches that the pad can comprise further of a foam pad to provide more support and padding. At the time of the invention, it would have been obvious to one skilled in the art to include a foam pad with the pad to provide more support and padding.

22. Claims 25-26, 31-33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (U.S. 5,288,286) in view of Grim. Davis discloses in figs. 1-5, an orthopedic support that includes a molded pad (20) for cushioning wherein the pad includes interconnected cells and a heel bladder fluidically coupled to the pad for varying the pressure exerted by the pad on the limb of the user. Davis does not disclose substantially rigid shell or the pad being injection molded. Grim discloses in column 3, lines 14-18 that it is known in the art to include a rigid shell on an orthopedic support for providing support to the user. In addition, it is known to make a pad by an injection molding process for cost effectiveness. It would have been obvious to one having ordinary skill in the art to include a rigid support for additional support for the user during use.

23. Referring to claim 26, Davis discloses the pad is a bladder having geometrically shaped cells to provide differing levels of cushioning.

24. Referring to claim 31, Davis discloses that the pad includes a plurality of integrally molded fingers (some of the bladders) extending from the pad to the shell.

25. Referring to claim 32, Grim disclose in figs. 9-11 that the pad forms an over-mold molded to the shell. It would have been obvious to one skilled in the art to place the pad on the shell in various arrangements, including forming an over-mold molded to the shell.

26. Referring to claim 33, see the above rejection of claim 25. It would have been obvious to one skilled in the art to attach the pad to the shell by numerous methods including bonding, as Grim teaches in column 7, line 20.

27. Referring to claim 36, see above rejection of claim 31.

28. Referring to claim 37, see above rejection of claim 32.

29. Referring to claim 38, see above rejection of claim 33 regarding bonding.

30. Claims 30, 34, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied to claim 6 above, and further in view of Brim (U.S. 4,977,891). Referring to claim 30, see rejection of claim 6 above.

31. Referring to claim 34, Grim teaches in column 4, lines 57-66 that some inflatable bladders include foam for additional cushioning.

32. Referring to claim 40, Grim teaches in column 4, lines 49-56 that some bladders include air holes to provide a bleed function that may not be accomplished through a relief valve.

33. Claim 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Peters. Peters discloses that the insert and outer shell are adapted such that they are securable into the indentation using a hook and loop fastener. It is known in the art to attach pads to shells in numerous ways, including using a snap. A snap is adapted to secure into an

indentation by snap fit. It would have been obvious to adapt the insert to secure the shell in numerous ways including using a snap fit.

Allowable Subject Matter

34. Claims 12, 28-29, 35, 39, 41, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35. Claims 50, 52, and 54-56 are allowable over the prior art of record. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest the elements recited in these claims, such as fingers of greater length in the malleolar region, a shell with a removable core, and an over-mold forming a ridge

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn C Mathew whose telephone number is (703) 305-2846. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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October 31, 2003


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